

REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed November 29, 2005. Claims 1-69 and 77 were pending in the Application prior to the outstanding Office Action. Claims 5-9, 26, 43, 58 and 77 have been amended. These amendments are supported in the specification at least at paragraphs [0019], [0021] and [0022]. Claims 1-69 and 77 remain for the Examiner's consideration. Reconsideration and withdrawal of the rejections are respectfully requested.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

Claims 5 and 43-69 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant has amended each of these claims as suggested by the Examiner.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 112 rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 101

Claims 6 and 8 are rejected under 35 U.S.C. §101 because they are drawn to non-statutory subject matter. The Applicant has amended each of these claims as suggested by the Examiner.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 101 rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-9, 13-26, 30-43, 47-58 and 62-77 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,415,659 to Lee et al. (hereinafter

'659). The Examiner points out that in '659 "...the spacer has a first end for contacting a first vertebrae, a beam extending from the first end ... [t]he beam is capable of being mounted to the base and the base is capable of being mounted to a second vertebrae".

Claims 1-6.

However, the '659 patent requires the first end is also attached to the first vertebrae "...has three hooks which cooperate with each other to releasably attach pedicle clamp to selected vertebrae of a patient's spine". Column 3, lines 32-35. In contrast, the Applicant's amended Claim 1 contains the limitation that the first end is not attached to the first vertebrae. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 1. Claims 2-8 each depend from currently amended claim 1 and are believed patentable for at least the same reasons as independent claim 1 and because of the additional limitations of these claims.

Claims 7 and 8.

Similarly, amended Claim 7 includes the limitation that the spacer is not attached to the first vertebra. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 7. Claim 8 depends from currently amended Claim 7 and is believed patentable for at least the same reasons as independent Claim 7 and because of the additional limitations of this claim.

Claims 9 and 13-25.

Amended Claim 9 includes the limitation that the implant is not attached to the L5 vertebra. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 9. Claims 13-25 each depend from currently amended claim 9 and are believed patentable for at least the same reasons as independent claim 9 and because of the additional limitations of these claims.

Claims 26 and 30-42.

Amended Claim 26 includes the limitation that the bean is not attached to the second vertebra. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 26. Claims 30-42 each depend from currently amended claim 26 and are believed patentable for at least the same reasons as independent claim 26 and because of the additional limitations of these claims.

Claims 43 and 47-57.

Amended Claim 43 includes the limitation that the bean is not attached to the second vertebra. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 43. Claims 47-57 each depend from currently amended claim 43 and are believed patentable for at least the same reasons as independent claim 43 and because of the additional limitations of these claims.

Claims 58 and 62-69.

Amended Claim 58 includes the limitation that the bean is not attached to the second vertebra. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 58. Claims 62-69 each depend from currently amended claim 58 and are believed patentable for at least the same reasons as independent claim 58 and because of the additional limitations of these claims.

Claim 77.

Amended Claim 77 includes the limitation that the spacer is not attached to the second vertebra. Since the '659 patent does not disclose all limitations of the present invention it does not anticipate the currently amended Claim 77.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 102(b) rejection.

CLAIM REJECTIONS UNDER 35 U.S.C. § 103

Claims 10-12, 27-29, 44-46 and 59-61 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,415,659 to Lee et al. (hereinafter '659). The Examiner argues that '659 disclose the claimed invention except for the implant being made from a material such as polyetheretherketone, polyaryletheretherketone, polyetherketoneketone, polyetherketoneetherketoneketone, polyetheretherketoneketone, polyketone, polyetherketone and titanium and that it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device from such a material.

However, '659 does not teach or suggest the claimed invention as detailed in the reply to the 35 U.S.C. 102(b) section above for amended Claims 9, 26, 43 and 58. Claims 10-12, 27-29, 44-46 and 59-61 each depend from currently amended Claims 9, 26, 43 and 58 respectively and are believed patentable for at least the same reasons as independent Claims 9, 26, 43 and 58 and because of the additional limitations of these claims. In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejection.

CONCLUSION

In light of the above, it is respectfully requested that all outstanding rejections be reconsidered and withdrawn. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this reply, including any fee for extension of time, which may be required.

Respectfully submitted,

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